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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,011	09/25/2006	Ikuo Yamamoto	Q97191	6195
23373 7590 12/10/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER BUIE, NICOLE M	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 12/10/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/594,011

**Applicant(s)**

YAMAMOTO ET AL.

**Examiner**

NICOLE M. BUIE

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on 09/02/2008 has been entered. Claims 1-8 and 10-14 remain pending in the application. Claims 15-20 have been added. The previous objection to the specification is withdrawn in light of Applicant's amendment to the specification.

### ***Claim Objections***

**Claim 3** is objected to because of the following informalities: claim 3 is not actually a complete claim in that it does not recite a positive step. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1, 2, and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Izumi et al. (WO 2004078476 A1, see English equivalent US 2006/0269741 for citation) as

evidenced by Izumi et al. (Chem. Abstract. 2004:754491 "Layered Product, Optical Part, Processes for Producing These, and Coating Fluid, 2004, 2 pages).

**Regarding claims 1 and 15**, Izumi et al. discloses a surface treatment agent comprising (1) a fluorine-containing polymer characterized in that the fluorine-containing polymer comprises repeating units from  $\text{CH}_2=\text{CH}-\text{COOCH}_2\text{CH}_2\text{SO}_2\text{C}_8\text{F}_{17}$  ("Megafac F-470") ([0144] as evidenced by Izumi et al. (Chem Abstract) and (2) an organic solvent [0047].

However, Izumi et al. does not disclose a specific fluorine-containing compound of formula (I) wherein the  $\text{R}_f$  is a perfluoroalkyl group having 1 to 6 carbon atoms. It would have been obvious to one of ordinary skill in the art at the time of invention to shorten the number of carbons in the perfluoroalkyl group of Izumi et al. to modify solubility. An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound in the expectation that compounds similar in structure will have similar properties. *In re Payne*, 606 F. 2d 303, 313, 203 USPQ 245, 254 (CCPA 979). See *In re Papesch*, 315.2d 381, 137 USPQ 43 (CCPA 1963) and *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1991). See MPEP 2144.09.

**Regarding claim 2**, Izumi et al. discloses a surface treatment agent which is in the form of a solution ([0047], see Example 5 for a similar composition but with a different fluorosurfactant).

**Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Izumi et al. (WO 2004078476 A1, see English equivalent US 2006/0269741 for citation) as evidenced by

Izumi et al. (Chem. Abstract. 2004:754491 “Layered Product, Optical Part, Processes for Producing These, and Coating Fluid, 2004, 2 pages) as applied to claim 1 above.

**Regarding claims 3 and 4**, Izumi et al. discloses a surface treatment agent as shown above in claim 1. Izumi et al. further discloses a method of treating a substrate (i.e. plastic lens base material) with the surface treatment agent [0052].

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. The following comments apply:

A) Neither Coover, Jr. et al. or Ohmori et al. disclose the specific fluorine-containing polymer of formula (I).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-8 and 10-21** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/594,148. Although the conflicting claims are not identical, they are not patentably distinct from each other because Appln '148 recites a structure for fluorine-containing compound having a fluoroalkyl group with a carbon number from 1 to 6 or 1 to 4 which encompasses the claimed compound wherein additional atoms may be present. Appln '148 encompasses the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. M. B./  
Examiner, Art Unit 1796  
12/3/2008

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796